

REMARKS

The application included claims 1-17 and 19-30 prior to entering this response.

Claims 17 and 19-22 have been allowed.

Claims 1-16, 18, and 23-30 were rejected.

The application remains with claims 1-17 and 19-30 pending.

APPLICANT'S COMMENTS ON EXAMINER'S STATEMENT OF REASONS FOR ALLOWANCE

Applicant thanks the Examiner for the consideration and indication for allowance of claims 17 and 19-22. Although the Applicant's attorney agrees with the Examiner's conclusion that these claims are allowable, the Applicant's attorney notes that the claims may be allowable for reasons other than those identified by the Examiner and does not concede that the Examiner's characterizations of the terms of the claims and the prior art are correct.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1-16 and 23-30 under 35 U.S.C. § 103(a) over Neukermans *et al.* (U.S. Patent 6,608,297) in view of Yoshii *et al.* (U.S. Patent 6,000,867), and further in view of Ara *et al.* (U.S. Patent 5,889,597).

The rejection is respectfully traversed.

In response to Applicant's prior amendment and argument, dated March 18, 2008 the Examiner stated a test for obviousness and cites case law from *In re Keller* in support (see page 2, section 1 of the June 24, 2008 Office Action). Even assuming, however, that the Examiner has stated the proper test for obviousness, Applicant respectfully submits that the Examiner has failed to address the arguments provided by the Applicant. Applicant did not merely state that the combination of Neukermans, Yoshii, and Ara fails to disclose the features recited by the rejected claims; rather, Applicant provided a reasoned argument identifying with particularity why these references fail to disclose the features of the rejected claims, even if the references were to be combined as proposed by the Examiner. For example, the Applicant explained why Ara failed to cure the deficiencies of Neukermans, as acknowledged at page 5 of the present Office Action. Instead of responding to Applicant's arguments with respect to Ara, point by point, the Examiner copied verbatim the paragraph from the prior Office Action dated December

18, 2007 which alleges that the features are disclosed by Ara (see page 5, third paragraph of the June 24, 2008 Office Action).

Accordingly, Applicant has prepared this response after final to afford the Examiner a further opportunity to consider Applicant's arguments in detail. First, with respect to the rejection of claim 1, the Applicant directs the Examiner's attention to pages 9 and 10 of the prior March 18, 2008 amendment. For the Examiner's consideration, the text of the prior argument is provided below:

Neukermans discloses a digital personal organizer 252 including a scanner 100 (see FIG. 5). The Examiner acknowledged at page 4 of the December 18, 2007 Office Action that Neukermans fails to disclose that a scanning channel and an operation panel respectively lie in substantially parallel planes and substantially overlap one another in a direction substantially perpendicular to the substantially parallel planes. Instead the Examiner cited Ara as reciting these features. Specifically, the Examiner cited the operation buttons 3, status display section 4, outer casing 2, scanning 8, and a paper ejection port 17 of Figures 1 and 2, and as described at column 4 lines 1-5 and lines 15-60.

While the Examiner appears to have identified the operation buttons 3 and status display section 4 of Ara as disclosing the operation panel of claim 1, it is not clear what the Examiner considers to disclose the scanning channel. Applicant assumes that the Examiner intended to identify the paper ejection port 17 as disclosing the scanning channel of claim 1.

Ara discloses a scanner 8 mounted to a printer 1. Applicant would like to first point out that the ejection port 17 is located on the scanner 8, whereas the operation buttons 3 and status display 4 are located on the printer 1, such that it would be impossible for them to lie in substantially parallel planes and substantially overlap one another in a direction substantially perpendicular to the substantially parallel planes, as recited by claim 1. Furthermore, even assuming the Examiner intended to identify the paper ejection port 7 associated with the printer, Applicant points out that the paper ejection port 7 of the printer is not a scanning channel.

For argument's sake, assuming the paper ejection port of the printer could be considered a scanning channel, Figure 1 of Asa clearly shows that the paper ejection port 7 is located to the left of the operational buttons 3 and status display 4 (e.g. the document 6 is shown being fed adjacent the status display 4). Accordingly, neither of the paper ejection ports 7, 17 of the printer 1 or scanner 17 of Ara disclose wherein a scanning channel and an operation panel respectively to lie in substantially parallel planes and substantially overlap one another in a direction substantially perpendicular to the substantially parallel planes. Claim 1 is therefore believed to be allowable.

Second, Applicant respectfully submits that the Examiner has failed to address Applicant's argument that the references fail to disclose the features recited by claim 23, as previously argued at pages 10 and 11 of the March 18, 2008 Amendment. For the Examiner's consideration, the text of the prior argument is provided below:

Claims 2-16, 23 and 24 are believed to be allowable as depending on claim 1 and for the further features recited therein. For example, new claim 23 recites the handheld Multi-Function Peripheral according to claim 1 further comprising two photoelectronic imaging devices located on opposite sides of the scanning channel, wherein the scanning apparatus is capable of concurrently scanning the opposite sides of the to-be-scanned document. None of the cited references disclose a scanning apparatus capable of concurrently scanning the opposite sides of a to-be-scanned document.

Claim 25 recites an apparatus comprising:

- means for entering a scanning job;
- means for transmitting a document through a scanning channel;
- means for scanning a first image located on a first side of the document;
- and
- means for scanning a second image located on a second side of the document, opposite the first side, wherein the first and second images are concurrently scanned.

Claim 25 is believed to be allowable for similar reasons as provided above with respect to claim 23. In rejecting claim 25, the Examiner cited column 9 lines 45-53 of Yoshii as

disclosing means for scanning a second image located on a second side of the document, opposite the first side, wherein the first and second images are concurrently scanned. Yoshi states that “The dual sided capturing means 62 controls the mechanical parts of the scanner unit for reading images on both sides of a single sheet of a manuscript in one operation...” Applicant respectfully submits that “one operation” does not disclose “concurrently”, and when read in view of the remainder of the Yoshii specification, it is understood that “one operation” instead refers to an operation in which both sides of the manuscript are scanned sequentially.

As Applicant pointed out to the Examiner in previous amendments, the Yoshi reference discloses a dual side scanner 62, in which both sides of a document are scanned sequentially (see the Abstract, col. 7, lines 66 to col. 8, line 2 and various Figures 1-12) by passing the document through the scanner twice. A sequential scanning of a front and reverse side of the document is different than a substantially concurrent scanning of the two sides of the document. For example, sequentially scanning both sides of the document could take twice as long as compared to substantially concurrent scanning.

The embodiments illustrated and described with reference to Figures 1-12 of Yoshii are incapable of substantially concurrently scanning two sides of a to-be-scanned document. As succinctly stated in the Abstract of Yoshii, “after the paper has been temporarily removed from the platen roller due to movement, the paper being returned in the opposite direction... in such a manner that an image on the reverse or the front of the paper is read out.” The control part 3 illustrated in Figure 13 and described in the Examiner’s citation at column 9 lines 45-53 is a component of the system illustrated in figures 1-12 (see Figure 1 including reference number 3 and column 4 lines 48-52). One skilled in the art would appreciate that the dual sensor 62 referred to in Figure 13 refers to the ability of the scanner head 8 to scan both sides of the manuscript, sequentially, as described throughout the specification.

For argument’s sake, even assuming that Figure 13 discloses an embodiment separate from Figures 1-12, Yoshii does not provide adequate description to enable one of ordinary skill in the art to determine how the dual sensor 62 would be capable of substantially concurrently scanning two sides of a to-be-scanned document. Applicant respectfully submits that the Examiner is utilizing improper hindsight in reading claim features from Applicant’s claim 25 into the Yoshii reference when those features are not disclosed by, and in fact could not be made operable with, the embodiments provided therein.

Claims 26-30 are believed to be allowable as depending on claim 25, in addition to the further novel features recited therein. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-16 and 23-30. If the rejection of some or all of these claims is maintained, Applicant respectfully requests that the Examiner respond in sufficient detail to the arguments provided above to provide Applicant guidance in how best to resolve this difference in opinion.

CONCLUSION

For the foregoing reasons, the Applicant respectfully requests reconsideration and allowance of claims 1-17 and 19-30. The Examiner is encouraged to telephone the undersigned if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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